

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-22 are pending in the present application. Claims 1, 9 and 17 are amended by the present amendment to overcome the objection to the claims by replacing the term “on” with the term “of.” Thus, no new matter is added.

In the outstanding Office Action, Claim 1 was objected to as including informalities; Claims 1, 6-9 and 14-16 were rejected under 35 U.S.C. §103(a) as unpatentable over Dayal et al. (U.S. Pat. No. 7,046,352, herein “Dayal”); Claims 2 and 10 were rejected under 35 U.S.C. §103(a) as unpatentable over Dayal in view of Murakami et al. (U.S. Pat. No. 5,017,798, herein “Murakami”); Claims 3 and 11 were rejected under 35 U.S.C. §103(a) as unpatentable over Dayal in view of Murakami and Nikoonahad (U.S. Pat. No. 6,919,957, herein “Nikoonahad”); Claims 17-21 are allowable; and Claims 4, 5, 12, 14 and 22 were objected to as dependent upon a rejected base claim but would be allowable if rewritten in independent form.

Initially, Applicants gratefully acknowledge the early indication of the allowable subject matter in Claims 4, 5, 12, 14 and 17-22.

With respect to the objection of Claim 1 as including informalities, Claim 1 and similarly Claims 9 and 17 have been amended to replace the term “on” with the term “of.” Thus, Applicants respectfully request that the objection to Claim 1, be withdrawn.

Addressing now the rejection of Claims 1, 6-9 and 14-16 under 35 U.S.C. §103(a) as unpatentable over Dayal, Applicants respectfully traverse this rejection.

Claim 1 recites, in part,

a space separation mechanism which is provided in the vicinity of an optical focal plane toward the pattern formed surface of the substrate, and spatially separates an irradiation area of the first inspection light and the second inspection light

such that the transmitted light through the substrate is imaged in one area on the optical focal plane separated from another area where the reflected light from the substrate is imaged.

Claim 9 recites similar features.

Dayal describes a method of conducting surface inspections using summed light.

The outstanding Office Action acknowledges on page 3 that Dayal does not describe or suggest a space separation mechanism which is provided in the vicinity of an optical focal plane toward the pattern formed surface of the substrate, and spatially separates an irradiation area of the first inspection light and the second inspection light such that the transmitted light through the substrate is imaged in one area on the optical focal plane separated from another area where the reflected light from the substrate is imaged, as is recited in Claim 1.

However, the outstanding Action goes on to state on page 3 that

However, since Dayal does not limit the transmitted light and reflected light to coaxial beams that pass through or reflect from the same point, it would have been at least obvious to one having ordinary skill in the art at the time of invention was made to spatially separates an irradiation area of the first inspection light and the second inspection light such that the transmitted light through the substrate is image in one area on optical focal plane separated from another area where the reflected light from the substrate is imaged for the purpose of measuring multiple location/area simultaneously with accuracy

In response, Applicants respectfully submit that there is no “rational underpinning” under KSR v. Teleflex, 550 U.S. ___, 127 S. Ct. 1727 (2007) for the finding that Dayal does not limit the transmitted light and reflected light to coaxial beams that pass through or reflect from the same point.

On the contrary, Dayal ***specifically states in col. 5, lines 14-18*** that the transmitted beam 106 and the reflected beam 104 ***are coaxial beams that pass through the same point on the inspection surface 110***. Therefore, the Dayal reference clearly teaches away from the features of the space separation mechanism recited in the independent claims of the claimed invention.

Thus, it would not have been obvious to one skilled in that art at the time that the claimed invention was made to spatially separate an irradiation area of the first inspection light and the second inspection light such that the transmitted light through the substrate is imaged in one area on optical focal plane separated from another area where the reflected light from the substrate is imaged for the purpose of measuring multiple location/area simultaneously with accuracy.

In addition, it appears as though the outstanding Action is relying on inherency in the rejecting the claimed invention. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). However, the spatial separation recited in the claimed invention not only does not necessarily flow, but clearly cannot flow, from the teachings of Dayal, at least, due to the fact that Dayal only describes that the transmitted beam 106 and the reflected beam 104 pass through the same point.

Therefore, Applicants respectfully submit that Clams 1 and 9, and claims depending therefrom, patentably distinguish over Dayal.

In addition, none of the further cited Murakami and Nikoonahad references cures the above noted deficiencies of Dayal with regard to Claims 1 and 9.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Eckhard H. Kuesters
Attorney of Record
Registration No. 28,870

I:\ATTY\JL\251154us\251154us_AM(11.8.2007).doc